

### REMARKS

In the November 1, 2007 Final Office Action, the Examiner rejects Claims 1-52 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,944,584 to Tenney, et al., ("Tenney") in view of U.S. Patent No. 7,194,489 to Bentley, et al., ("Bentley"). Applicants request reconsideration of the rejections in view of the following comments.

#### Rejection of Claims 1, 27, and 40

In rejecting Claims 1, 27, and 40, the Examiner acknowledges that "Tenney doesn't expressly disclose permitting the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer application to be developed." (Page 3, lines 5-7).

The Examiner uses Bentley to provide the missing limitations. As will be described later under the heading titled "Inadequate Basis for Combining Tenney and Bentley," Applicants also respectfully submit that it is improper to combine Tenney and Bentley in the manner proposed by the Examiner. In addition, Applicants respectfully submit that the Examiner's claim interpretation is unreasonable and that even if Bentley and Tenney were to be combined, a combination of Bentley and Tenney does not teach or suggest a reasonable interpretation of the claimed invention.

While Applicants acknowledge that the Examiner is permitted to interpret claim language broadly, such interpretation must nonetheless still be reasonable. "The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). See MPEP 2111. See also, *In re Buszard*, 504 F.3d 1364 (Fed. Cir. 2007).

The Examiner's claim construction reads out the element "simulation program of the computer application to be developed" from "communicating with a plurality of user computers, where the user computers display an executable simulation model of the simulation program of the computer application to be developed" and "permitting the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer

application to be developed,” as recited in Claim 1; “a first component configured to communicate with a plurality of user computers, where the user computers display an executable simulation model of the simulation program of the computer application to be developed,” and “a second component configured to permit the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer application to be developed, where the second component is further configured to receive a modification to the executable simulation model from a first user computer selected from the user computers,” as recited in Claim 14; and “a means for communicating with a plurality of user computers, where the user computers display an executable simulation model of the simulation program of the computer application to be developed,” and “a means for permitting the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer application to be developed,” from Claim 27.

Applicants explained in the prior response that Tenney teaches developing *deployable* software with a software simulation of *hardware*. Tenney teaches “simulated testing of the robotic software before the robotic hardware has been fully developed,” (Col. 1, lines 36-38). Tenney states that “the combined client/server system may be fully tested offline in pure simulation mode before being connected to the actual system hardware,” (Col. 8, lines 6-8). Tenney states that “[t]he software development track 843, however, begins by *simulating hardware devices*, and gradually integrating the application hardware as it becomes available,” (Col. 10, lines 43-45) (emphasis added). Tenney describes the benefit as that “[a]fter the device control program has been fully tested in simulation, *the same program* can be used to control actual devices,” (Col. 2, lines 38-40) (emphasis added). For example, the simulation “warns developers of potential collisions that will occur before control software is used with the actual hardware devices during development and simulation of new robotic workcells,” (Col. 9, lines 46-46).

Thus, “the same program” (Col. 2, lines 39-40) is used in the simulation of Tenney. Rather than simulate a program, but Tenney is concerned with “simulating hardware devices,” (Col. 10, line 44). When given its broadest reasonable interpretation, the claim language: “permitting the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer application to be developed,” does not

read on the development of deployable software using a simulation of hardware. In addition, Applicants note that Bentley also does not teach or suggest a simulation program of a computer application. The only instance of "simulation" in Bentley is in connection with "making electronic engineering simulations more powerful and reliable," (Col. 1, lines 63-64) which is also descriptive of hardware simulation.

Therefore, Applicants respectfully maintain that the combination of Tenney and Bentley does not teach or suggest the invention as claimed and request the Examiner to withdraw the rejections of Claims 1, 27, and 40. Accordingly, Applicants request allowance of Claims 1, 27, and 40.

#### **Inadequate Basis for Combining Tenney and Bentley**

Applicants respectfully submit that it is improper to combine Tenney and Bentley in the manner proposed by the Examiner. The Examiner states that "it would have been obvious ... to combine Tenney and Bentley because it would enable being able to remotely edit the program as disclosed by Bentley above." Applicants disagree. Applicants respectfully submit that Tenney teaches away from a combination with Bentley.

"When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious," see Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 FR 57526, 57529, Col. 3, lines 14-18, citing *KSR*, 82 USPQ2d 1385 (2007) at 1395. The foregoing guidelines are downloadable at <<http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf>>. See also MPEP § 2145(X)(D)(2).

Tenney teaches away from a combination with Bentley. Tenney states that "[t]he server security system also prevents multiple users from simultaneously accessing critical control areas of the server software." (Col. 8, lines 55-57). Accordingly, Tenney teaches away from a configuration providing multiple users with simultaneous access and thus, Tenney and Bentley should not be combined. Accordingly, Applicants request the Examiner to withdraw the rejections of Claims 1-13 and 28-52 and to allow the same.

#### Rejection of Claim 14 and Request of Entry of Prior Amendment to Claim 14

While the Examiner states that "Applicant's arguments with respect to claims 1 - 52 have been considered but are moot in view of the new ground(s) of rejection," (page 6), it appears that the Examiner has not entered Applicants' amendment to Claim 14. The Examiner's rejection does not address the amendments to Claim 14 made in the prior response and is identical to the rejection of Claim 14 from the Office Action of May 17, 2007. Applicants request entry of the amendment to Claim 14 made in the prior (non-Final) response and reconsideration of the rejection of Claim 14, as amended. "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." M.P.E.P. § 706.7

In addition, while the Examiner states that "Claims 1 - 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tenney et al. US 6,944,584 B1 in view of Bentley et al. USPN 7,194,489," (page 2), the Examiner states that "[r]egarding claim 14, Tenney *anticipates* a computer system..." (page 6) (emphasis added) and does not discuss Bentley in the rejection of Claim 14. It thus appears that the Examiner intended to reject Claim 14 under 35 U.S.C. § 102. Accordingly, Applicants proceed to respond to the rejection as anticipated under 35 U.S.C. § 102.

The Examiner states that Figure 1, items 119 and 100 and associated text, Col. 2, lines 40-50, and Col. 7, lines 45-50 of Tenney teach the invention as claimed. As previously amended, Claim 14 recites that the "simulation program" is "of the computer application to be developed," which is not taught by Tenney. As described earlier in response to the Examiner's rejections of Claims 1, 27, and 40, Tenney teaches that a simulation of hardware for the development of deployable software, and not a simulation of software.

Moreover, in the rejection of Claims 1, 27, and 40, the Examiner acknowledges that "Tenney doesn't expressly disclose permitting the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer application to be developed." (Page 3, lines 5-7). Thus, Applicants respectfully submit that Tenney does not teach or suggest, for example, "a second component configured to permit the user computers to simultaneously modify the executable simulation model thereby revising the simulation program of the computer application to be developed, where the second component is further configured

to receive a modification to the executable simulation model from a first user computer selected from the user computers,” as claimed.

Accordingly, Applicants request the Examiner to withdraw the rejection of Claim 14 and to allow Claim 14.

However, if the Examiner intended to reject Claim 14 under 35 U.S.C. 103(a) as being unpatentable over Tenney in view of Bentley, then the Examiner failed to make a *prima facie* case of obviousness and so Applicants respectfully traverse the rejection under 35 U.S.C. 103(a). The Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (“Examination Guidelines”), which were published in the Federal Register Vol. 72, No. 195 (Docket PTO-P-2007-0031) on October 10, 2007, clarify the Supreme Court’s decision on *KSR Int’l. v. Teleflex, Inc.* with regard to the issue of obviousness under 35 U.S.C. §103(a) in relation to prior art. *KSR Int’l. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). Applicant submits that the outstanding Office Action fails to satisfy the Examiner’s burden in establishing an obviousness rejection. Under the Examination Guidelines, a rejection must offer specific support for the following rationales Examiners may use to show obviousness:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

**Application No.:** 10/763,012  
**Filing Date:** January 22, 2004

Because the Examiner failed to provide any offer specific support under any of the foregoing rationales to show obviousness over Tenney in view of Bentley, the rejection of Claim 14 under 35 U.S.C. 103(a) is improper and should be withdrawn.

**Discussion of Rejection of Dependent Claims 2-13, 15-26, 28-39, and 41-52**

Dependent Claims 2-13, 15-26, 28-39, and 41-52 depend from and further define Claims 1, 14, 27, and 40, respectively. The dependent claims recite numerous additional distinctions over the cited references. In addition, Applicants respectfully submit that the rejections to dependent Claims 2-13, 15-26, 28-39, and 41-52 are moot for at least the reasons described for Claims 1, 14, 27, and 40, respectively, and Applicants accordingly request allowance of Claims 2-13, 15-26, 28-39, and 41-52.

**No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

**Co-Pending Applications of Assignee**

Applicants wish to draw the Examiner's attention to the following co-pending applications of the present application's assignee.

Serial Number	Title	Filed
10/484,541	SYSTEM AND PROCESS FOR GATHERING, RECORDING AND VALIDATING REQUIREMENTS FOR COMPUTER APPLICATIONS	Jan. 22, 2004

Application No.: 10/763,012  
Filing Date: January 22, 2004

10/762,428	SYSTEMS AND METHODS FOR A PROGRAMMING ENVIRONMENT FOR A SIMULATION OF A COMPUTER APPLICATION	Jan. 22, 2004
11/671,331	SYSTEMS AND METHODS FOR DEFINING A SIMULATED INTERACTIVE WEB PAGE	Feb. 5, 2007

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Jan 2, 2008

By: Michael S. Okamoto  
Michael S. Okamoto  
Registration No. 47,831  
Attorney of Record  
Customer No. 20,995  
(310) 551-3450

4694806\_1  
010208